

REMARKS

DISCUSSION OF CITED ART

Walker

Walker discloses a customer who receives a device upon entering a store, and uses that device to select a prize and to pay for the chance to win that prize in a game. Once the customer pays the fee, he does nothing further, except wait for the outcome. If the customer wins the game, the prize is shipped to his home. If he loses, he receives a consolation prize: namely a discount applicable towards buying the prize. This method is intended to make the shopping experience more exciting.

The prize could presumably be anything the store sells, including a DVD. Thus, if the customer were to select a DVD as his prize, and if he were to then win the lottery, the DVD would be shipped to his house.

Walker does not disclose electronically transmitting the prize to the customer. In Walker, the only way the customer gets his prize is by shipment.

Nakano

Nakano discloses a video recorder that automatically deletes content when that content has been stored for too long.

Combination of Walker and Nakano

The combination of Walker and Nakano would result a customer winning a prize, only to find the prize taken away after the lapse of some interval. If one were to entertain the notion that the prize is multimedia content downloaded to the customer's computer (which Walker does not actually disclose), then the combination would result in having a server reach into the customer's computer to take away his prize.

SECTION 103 REJECTION OF CLAIM 1

As best understood, the Office regards Walker's retail controller 100 as corresponding to claim 1's "server" and Walker's customer devices 200-202 as corresponding to claim 1's "plurality of clients."

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Walker's customer devices do not play any game

Claim 1 recites

“at a server ...receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients”

The Office states that the customer devices 200-202 in Walker correspond to claim 1's “plurality of clients.”

Walker's customers do not play an online game on customer devices 200-202. According to Walker, the customers use their devices to select a product, to pay a fee to play the game, and to receive the proceeds associated with the outcome of the game. The game itself is played at the retail controller, without the customer's participation. Neither the customer device nor the customer are needed to play the game.

In Walker, the customer designates a prize, and pays a fee to enter a lottery to win that prize. But the lottery itself is played at the retail controller, not on a customer device. Once the customer pays his fee, the game proceeds to completion. Nothing the customer does can have any influence on the game's outcome.

Walker's server does not receive information about completing a game challenge

Claim 1 further recites

at the server ...receiving information indicating that a first player from the plurality of players has completed a game challenge associated with the goal-activated content

The Office cites col. 4, lines 6-25 as disclosing the foregoing limitation. This text is shown in the following passage:

The customer selects a product by selecting a displayed hyperlink corresponding to the product. In response, the web server transmits a web page to the Web browser including a view, a description and a price of the product. The web page also includes a hyperlink selectable to indicate that the customer desires to play a game for the product. Once this hyperlink is selected, the web server determines a fee required to play the game based on a retail price of the product and on a probability that the game will result in a winning outcome. For

example, if the product has a retail price of \$10 and the probability of a winning outcome is 0.1 (i.e. 1 in 10 plays results in a winning outcome), the fee is determined to be \$1. The fee is charged to the customer using a payment identifier previously provided by the customer.

The game, such as a slot machine game, is then executed and the outcome of the game is determined. If the outcome is a winning outcome, the product is shipped to the customer without charging the customer any additional fee for the product, except perhaps a shipping and handling fee. If the outcome is a losing outcome, a web page is transmitted to the customer informing the customer that she did not win the product but that she possesses a credit equal to the \$1 fee which is applicable towards the purchase of the product. Accordingly, the customer may purchase the product for \$1 less than the retail price of the product.

There are three reasons why the foregoing text fails to meet the claim limitation:

First, the cited text describes information being received “at the client,” and not “at the server” as the claim requires.

Second, the cited text does not describe the customer device receiving information indicating that the customer “has completed a game challenge.” According to the cited text, if the customer wins, “the product is shipped to the customer.”

Third, in Walker, the customer does not actually complete any game challenge. In fact, after paying the fee, the customer does nothing more except await the outcome of the game. Nothing the customer does can influence the game’s outcome. Accordingly, there is no “game challenge” in the game described by Walker.

Walker fails to disclose hosting multimedia content for transmission

Claim 1 further recites

at a server, hosting, for transmission, multi-media content designated as goal-activated content for an online game;

The Office does not state where Walker discloses hosting multimedia content. Instead, the Office speculates that Walker's store could be selling CD's, DVD's, and MPEG, all of which carry multimedia content.

As a threshold matter, nowhere does Walker disclose that CD's, DVD's, and MPEG are for sale.

However, even if such items were for sale, nowhere does Walker suggest that the multimedia content carried by these media are hosted for transmission. Walker discloses shipping products to customers. Thus, all the evidence suggests that multimedia content for sale is provided on some physical medium, which the customer physically possesses. There is no teaching or suggestion of hosting any multimedia content for transmission.

In fact, Walker clearly states that any multi-media content sold would be sold as goods:

To insure clarity of the following description, set forth below are definitions of several terms used herein. The scope of the present invention is not to be deemed limited by the definitions.

Product: A good and/or a service. The term product may also be used herein to refer to one or more related or unrelated goods and/or services.

Retailer: An entity which sells products to customers. Such entities include proprietors of traditional retail stores, proprietors of online retail stores, product manufacturers, product warehouseers, and online storefront providers.¹

Multimedia content not a "good;" it is information. "Information" is not "goods." For example, according to UCC 2-103(k)

"(k) "Goods" means all things that are movable at the time of identification to a contract for sale. The term includes future goods, specially manufactured goods, the unborn young of animals, growing crops, and other identified things attached to realty as described in Section 2-107. **The term does not include information,** the

¹ Walker, col. 3, lines 35-43.

money in which the price is to be paid, investment securities under Article 8, the subject matter of foreign exchange transactions, or choses in action.”²

The Office’s position, that Walker discloses downloading multimedia content, is thus flatly contradicted by the text of Walker itself. There is no evidence on the record that Walker would have disclosed or suggested to one of ordinary skill in the art the hosting of multimedia content for transmission.

Nakano fails to disclose instructing client to delete content

Nakano discloses a video-recorder that knows how long certain content has been saved. When the shelf life of that content is exceeded, the video recorder deletes it.

Claim 1 recites:

“at a server... instructing the first client to delete the goal-activated content stored on the first client”

Nakano cannot disclose this limitation because there is no client/server relationship disclosed in Nakano. The Nakano video recorder does not instruct a client to delete content. In addition, there is no server that instructs the Nakano device to delete content. Instead, the Nakano device decides when it is time to delete certain content, and then proceeds to delete it.

Motivation to combine references

The Office relies on MPEP 2143 Rationale “D” for combining the references.

MPEP 2143-D requires that the base method be improved by the addition of the known technique. In other words, whatever the base method is supposed to do, it should somehow do it better when modified by the known technique.

Within the framework of MPEP 2143-D, the “base method” would be Walker’s method for injecting excitement into shopping. Thus, the stated function of the base

² UCC 2-203(k) [emphasis supplied]

method is to make the shopping experience more exciting. Therefore, an improvement to the base method should somehow make the shopping experience more exciting.

According to the base method, a customer selects a prize, and pays to enter a lottery to win that prize. If the customer wins, he receives the prize. If the customer loses, he receives a discount to purchase that prize. This method is intended to make shopping more exciting. Therefore, any improvement to this method should make shopping even more exciting.

The “known technique,” which would allegedly improve the base method, is deleting multimedia content from a disk after lapse of some interval. The result of applying the known technique to the base method would be to take away multimedia the customer’s multi-media content after some time has passed. This would allegedly improve the base method by making the shopping experience more exciting in some way.

The Office has not explained why one of ordinary skill in the art would have found the deletion of multimedia content to be any sort of improvement to the base method. Specifically, the Office has not shown why one of ordinary skill in the art would find that deleting the shopper’s multi-media content in the future would enhance his shopping experience.

The Office has contrived an elaborate rationale that relies on the possibility that a customer might choose, as his prize, something having copyrighted subject matter. According to the Office, in such a case, Walker would need some way to control dissemination of that subject matter.

But Walker already controls dissemination of prizes. If copyrighted multimedia content were not supposed to be distributed as a prize, then Walker would simply avoid distributing it. Nothing could be simpler. There is nothing to suggest that Walker’s method for enhancing the shopping experience would be improved in the least by first distributing multimedia content, and then, after the lapse of some time, reaching into a customer’s device and deleting the same multimedia content.

The Office's rationale thus amounts to inventing a problem where none exists, and proposing Nakano as its solution. Nothing in the disclosure of either reference, or in knowledge available at the time of invention, suggests that Walker's method was somehow deficient because it lacked sufficient control over dissemination of copyrighted subject matter.

The Office further rationalizes the combination of references by stating that "Walker can sell anything that can be found in any virtual or web store including CD's, MPEGs, or videos that have a limited shelf life."³

Applicant agrees that web stores can sell multimedia content. However, the Office has not provided any evidence that at the time of the invention, there existed "virtual or web stores" that sold multimedia content with a limited shelf life. Accordingly, the Office's rationale is not based on any evidence of record, but rather on mere speculation.

Nakano discloses receiving multimedia content with limited shelf life. But according to Nakano, this content is broadcast from a broadcasting facility, such as a TV station. A broadcaster and a store are not the same thing. There is nothing in Nakano to suggest the existence of a store, whether virtual or otherwise, that was in the business of selling multimedia content having a limited shelf life.

Accordingly, rationale D set forth in MPEP 2143 fails to provide a basis for the proposed combination of references because the Office has not demonstrated that one of ordinary skill in the art would have regarded deleting a shopper's multimedia content as being an improvement in Walker's system for enhancing the shopping experience. .

SECTION 103 REJECTION OF CLAIM 2, 11, AND 14

Claim 2 requires:

transmitting the goal-activated content to the first client in response to a determination that the first player has completed the game challenge

³ Office Action, page 3.

The Office defines the game challenge by stating that “the challenge of course is the winning outcome.”⁴

It is elementary that something cannot be “completed” until after it has “begun.” For this reason, it makes no sense to have “completed a winning outcome” for the same reason that it makes no sense to have “begun a winning outcome.” To say that one has “completed a winning outcome” makes absolutely no semantic sense.

A “winning outcome” cannot reasonably be regarded as “a challenge;” it is the result of meeting a challenge. One can “earn” a winning outcome by “completing” a challenge. But one cannot “complete” a winning outcome. A winning outcome cannot be “completed” because it cannot be “begun.”

Applicant understands that the Office is entitled to apply the broadest reasonable interpretation to “challenge,” but that interpretation must also be consistent with what one of ordinary skill in the art would have understood from reading the specification.

Claims 11 and 14 recite similar language and are patentable for at least the same reasons.

SECTION 103 REJECTION OF CLAIMS 3, 8, AND 16

Claim 3 recites the additional limitation of

“receiving a history profile from the first client”

According to the claim, the first client sends the history profile.

As disclosed in column 11, Walker maintains a purchase history for a particular customer. But the customer devices [i.e. clients] do not send this purchase history to the retail controller [i.e. the server] as required by claim 3.

⁴ Office Action, page 5.

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Claims 8 and 16 include limitations similar to claim 3 and are patentable for at least the same reasons.

SECTION 103 REJECTION OF CLAIMS 4, 9 AND 17

Claim 4 recites the additional limitation of:

instructing the first client to delete goal-activated content stored on the first client in accordance with the history profile.

The Office suggests that the foregoing limitation is disclosed at paragraphs 112-117 of Nakano.

The cited text merely describes how the pause and play buttons operate. There is no apparent connection between these buttons and the customer's purchasing history, as described in Walker, col. 11, lines 30-39.

As a basis for modifying Walker, the Office states that

"It would have been obvious upon reading Nakano to include checking history for proper time periods spent or history of the account to control the deletion system, allowing the player the flexibility to observe the content at his/her own timeline."⁵

The Office's reasoning makes no sense. Walker's history is a purchasing history. There is no apparent relationship between the customer's purchasing history and whether or not to delete certain content from the disk.

Claims 9 and 17 include similar limitations and are patentable for at least the same reasons.

SECTION 103 REJECTION OF CLAIM 5

Claim 5 recites the additional limitation of

"encrypting the goal-activated content prior to transmission to the first client"

⁵ Office action, page 6.

The Office suggests that encryption is inherent in MPEG files for the purpose of limiting play.

Applicant draws attention to MPEP 2112 (IV), which discusses the law of inherency. For example, the Federal Circuit has stated that

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” ... “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999).

The Board of Appeals has also stated that

“In relying upon the theory of inherency , the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art” *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)[emphasis in original]

The general rule of inherency is that if a feature necessarily follows from what has been expressly disclosed, then that feature is inherently disclosed. However, if the absence of the feature is also consistent with the express disclosure, then the feature is not inherently disclosed.

This rule is articulated in MPEP 2112:

“[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic”

as well as by the Board of Appeals:

“In relying upon the theory of inherency , the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art”⁶

and again, nine years later, by the Federal Circuit:

⁶ *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)[emphasis in original]

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed.Cir.1991). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” Id. at 1269, 948 F.2d 1264, 20 U.S.P.Q.2d at 1749 (quoting In re Oelrich, -, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A.1981)).⁷

A rejection that relies on inherency requires a showing that the allegedly inherent feature must exist given the disclosed features. Thus, the Office must establish that all MPEG files are necessarily encrypted. The Office has made no such showing.

Applicant submits that MPEG is simply a standard for encoding multimedia content. An MPEG file, just like any file, can be either left in clear-text or encrypted. The Office has presented no evidence to support the proposition that an MPEG file is necessarily encrypted, i.e. that it is impossible to have an MPEG file that has not been encrypted.

Unless the Office can provide evidence to show that the MPEG files in Nakano are necessarily encrypted, the claim limitation cannot be met.

The Office seems to suggest that encryption is disclosed at paragraphs 58 and 105.

Paragraph 58 uses the word “decode.” But decoding does not imply encryption. Decoding implies that encoding must have occurred. But encoding is not encryption. Neither is decoding the same as decryption. Accordingly, paragraph 58 has nothing at all to do with encryption or decryption.

Paragraph 105 describes how the CPU determines whether the content is too old to view. Paragraph 105 refers to a “time code.” But again this has nothing to do with encryption.

⁷ *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

Accordingly, Nakano does not disclose encryption of content prior to transmission to a client.

The Office further states it would have been obvious to modify Walker “to use the time encryption method in Nakano to establish the viewable period.”

As discussed above, it is unclear what the Office means by “time encryption method.”

In addition, Nakano appears to have no difficulty in establishing a viewable period. Nor is there any plausible viewable period to consider in Walker. Walker is concerned with awarding prizes to shoppers. There is no viewable period in Walker to determine.

SECTION 103 REJECTION OF CLAIM 6

Claim 6 requires

“transmitting, to the server, information indicating that a player has completed a challenge from the on-line game”

According to claim 6, information goes *to* the server, not *from* the server.

To the extent winning the lottery is regarded as completing a challenge in *Walker*, the customer does not transmit any such information back to the retail controller. In fact, it would make no sense at all for the customer to do so. After all, it was the retail controller that determined the outcome of the random process. So it is the retail controller that first becomes privy to the news that the customer has won the lottery.

As discussed in connection with claim 1, *Walker* does not teach “receiving the goal-activated content from the server.” In *Walker*, a customer who acquires a product would receive it through the mail, not from the server.

With regard to the deletion of goal activated content, Applicant draws attention to the discussion of *Nakano* in connection with claim 1.

For the foregoing reasons, the section 103 rejection of claim 6 is improper and should be withdrawn.

SECTION 103 REJECTION OF CLAIMS 10 AND 18

Claim 10 recites

receiving an instruction to delete all goal-activated content

Nakano discloses a video recorder that deletes only content that has been stored for too long. Nakano does not disclose deleting all content.

The Office suggests that one of ordinary skill in the art would have found it obvious to delete all content “to maximize improvement of *Walker/Nakano* invention by making it more versatile and easy to use.”⁸

The Office’s statement is a “mere conclusory statement” of the type forbidden by *KSR v. Teleflex*. It offers no reason for why one would have found it obvious to modify *Nakano* by allowing receipt of an instruction to delete all goal-activated content.

Contrary to the Office’s position, one of ordinary skill in the art would have recognized that deleting all content would result in deleting video programming that has only been recently placed on disk. This would defeat the purpose of *Nakano*, which is to delete only video programming that has been stored on disk for too long.

SECTION 103 REJECTION OF CLAIMS 12 AND 15

Claim 12 recites

“requesting goal-activated content in response to the completion of the game challenge.”

Thus, according to claim 12, the player first completes the challenge. After (and not before) completing the challenge, he can request the goal-activated content.

⁸ *Office Action*, page 4.

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In *Walker*, the order would be backwards: the player selects a prize, and then enters the lottery. He does not enter the lottery and then select his prize upon winning the lottery.

Claim 15 includes limitations similar to claim 12 and is patentable for at least the same reasons.

SECTION 103 REJECTION OF CLAIM 13

Claim 13 recites

“transmitting the goal-activated content to the client *over a network*.”

In *Walker*, products are shipped to the customer by conventional mail, and not transmitted “over a network” as required by claim 13. The only data transmitted to the client over any sort of network is a web page announcing the unfavorable outcome of the game.

With regard to the transmission of instructions to delete goal-activated content, Applicant draws attention to the discussion of *Nakano* in connection with claim 1.

Claim 13 also requires

transmitting to the client, over the network, instructions to delete the goal-activated content.

In *Nakano*, the instruction to delete content originates locally. There is no need to transmit deletion instructions “over the network” as recited in the claim.

SECTION 103 REJECTION OF CLAIM 20

The Office asserts that *Nakano* teaches the processor recited in claim 20.

Nakano teaches a video recorder for recording video programming on a disk and, after the lapse of some interval, automatically deleting that programming from the disk.

Claim 20 recites

“a processor configured for determining that the goal-activated content is to be transmitted to the client.”

The *Nakano* video-recorder does not transmit content. It only receives content. Accordingly, there would be no reason for Nakano’s processor to be “configured for determining that the goal-activated content is to be transmitted to the client.”

Claim 20 also recites

“a processor configured for... causing the transceiver to transmit the goal activated content to the client.”

As noted above, the *Nakano* video-recorder does not transmit content, whether goal-oriented or otherwise, to a client. Instead, it receives content from a broadcaster and saves it to disk.

Claim 20 further recites

“a processor configured for... causing the transceiver to transmit a deletion instruction for deleting the goal-activated content from the client.”

Nakano discloses a device that deletes content stored locally on its disk. *Nakano*’s device does not transmit a deletion instruction to some other device. Therefore, there is no processor that is configured for “causing the transceiver to transmit a deletion instruction.”

The Office concedes that *Nakano* fails to teach anything about “goal-activated content.” To remedy this deficiency, the Office draws attention to *Walker*.

As noted above, *Nakano* does not disclose a processor configured as claimed. *Nakano*’s lack of such teaching does not depend on whether the content is goal-activated or otherwise. Thus, to the extent *Walker* discloses goal-activated content (which, as discussed in connection with claim 1, it does not), such disclosure would be irrelevant. Even if the video programming described in *Nakano* were goal-activated content, *Nakano* would still fail to teach the limitations of claim 20.

The Office suggests that one of ordinary skill in the art would have found it obvious to modify *Nakano* to include goal-activated content “to make a web store more interesting for subscribers.”⁹

However, *Nakano* has nothing to do with web stores. *Nakano* is simply a video recorder for recording and automatically deleting video content. Such content comes off the air, via cable, or via a web site that broadcasts streaming data. No web store is involved in the operation of *Nakano*’s video-recorder.

The Office further states that “both references describe forms of obtaining products via a WEB store and any combination of the teachings would be obvious to one of ordinary skill in the art at the time of applicant’s invention and predictable.”¹⁰

As noted above, *Nakano* has nothing to do with web stores.

However, even if it did, the Office’s proposed reason to modify *Nakano* is a mere conclusory statement that, under *KSR v. Teleflex*, is inadequate to support a legal conclusion of obviousness. The statement merely states that two references are in the same general field of technology and concludes that as a result, any claim that includes some permutation or combination of features found in those references is per se obvious.

For reasons discussed above, *Nakano*, with its proposed modifications based on *Walker*, fails to render the subject matter of claim 20 obvious. Accordingly, Applicant requests reconsideration and withdrawal of the section 103-rejection.

SECTION 103 REJECTION OF CLAIM 21

Walker fails to disclose a multiplayer game

Claim 21’s preamble recites controlling access “in a *multiplayer* game.”

⁹ Office Action, page 6.

¹⁰ Office Action, page 6.

Walker does not disclose a multiplayer game. In *Walker*'s game, a player pays a fee and waits for an outcome. No other players are necessary. Additionally, other players who play concurrently have no effect on each others outcomes. To the extent *Walker*'s lottery is regarded as a game at all, it is a single player game that can be played by many people at the same time, like a slot machine. The game itself does not require multiple players.

Walker fails to teach storing content in association with states

Claim 21 recites

“storing content in association with each of a plurality of states that can be reached by at least some of the players.”

The Office states that this limitation is met by the following text at col. 3, lines 50-58.

Retail Store: Generally, a location at which products are offered for sale by a retailer. Traditionally, a retail store is a physical building in which a retailer offers and sells products to customers. Retail stores also include websites in which descriptions and visual representations of products for sale may be viewed by customers and through which the customers may purchase one or more of the products for sale.

The above passage simply describes a building in which one displays goods for sale. There is no suggestion that these goods are somehow stored “in association with each of a plurality of states.”

Applicant requests that the Office provide a verbatim quote of the text in the cited passage that allegedly discloses “states that can be reached by” players.

Walker fails to disclose maintaining player states

Claim 21 also recites

“maintaining a state for each player in a multiplayer game.”

The Office asserts that this limitation is disclosed in FIG. 8.

FIG. 8 is a flow chart showing the steps leading up to the game, and showing the steps that occur after the game is played. The game itself is entirely within the box labeled “execute game.” There is no disclosure of maintaining a state for each player during the execution of the game.

SECTION 112 REJECTION OF CLAIM 1

Claim 1 recites

receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients.

The Office alleges that one of ordinary skill in the art would not have understood that Applicant was in possession of this subject matter at the time of the invention.

As discussed in MPEP 2163.02, 35 USC 112 does *not* require the subject matter of a claim be described literally, using identical language. (i.e. using the same terms or in haec verba) in order for the disclosure to satisfy the written description requirement. In *Fujikawa v. Wattanasin*, the Court stated that “ipsis verbis disclosure is not necessary to satisfy the written description requirement of section 112. Instead the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question.”¹¹

In the present case, FIG. 1 shows a plurality of clients 112... 118. As indicated by paragraph 23, each client “facilitates a player’s operation of and interaction with the game.” FIG. 1 shows data communication between the clients and a server 102. One of ordinary skill in the art would readily have understood that if the servers did not receive any information about players playing the game on clients, the multi-player role playing game could not possibly work.

Paragraph 35 states that each server has a server platform portion for “communications, data base storage, coordination, and overall control and administration

¹¹ *Fujikawa v. Wattanasin*, 93 F.3d 1559 (Fed. Cir. 1996).

of the game,” and that servers “maintain state information and coordinate client interaction with... other clients.”

One of ordinary skill in the art would have understood that these functions could not possibly be carried out without “receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients.” This disclosure would have reasonably conveyed to one of ordinary skill in the art that the inventor was in possession of the idea of receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients.

Paragraph 37 states that a client who wishes to enter the game communicates with a server. Conversely, according to paragraph 38, the server communicates with each client concerning player data both for that client and for other nearby clients. One of ordinary skill in the art would have understood that receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients would have been a prerequisite for carrying out these functions and that the inventor must have been in possession of this subject matter at the time of invention.

In view of at least the foregoing disclosure, it is clear that one of ordinary skill in the art would have understood that the inventor was in possession of the subject matter “receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients.”

Claim 1 further recites

“receiving information indicating that a first player from the plurality of players has completed a game challenge associated with the goal-activated content”

Paragraph 41 discloses that clients can execute a “game challenge” and that upon completing such a challenge, a secret movie appears. One of ordinary skill in the art would have recognized that whatever causes the secret movie to appear must receive some sort of information indicating completion of the game challenge. Otherwise it would have no way of knowing when to show the secret movie.

Clearly, one of ordinary skill in the art would have understood from the disclosure of paragraph 41 that the inventor was in possession of subject matter described by “receiving information indicating that a first player from the plurality of players has completed a game challenge associated with the goal-activated content.”

Paragraph 48 discloses that a client associated with a player “informs the server that the goal has been fulfilled.” One of ordinary skill in the art would have understood this as being no different from “receiving information indicating that a first player from the plurality of players has completed a game challenge associated with the goal-activated content” and thus would have understood the the inventor was in possession of this subject matter.

FIG. 5’s step 506 refers to informing the server of goal fulfillment. One of ordinary skill in the art would have understood that this is no different from “receiving information indicating that a first player from the plurality of players has completed a game challenge associated with the goal-activated content.” Accordingly, one of ordinary skill in the art would have understood that the inventor was in possession of the foregoing subject matter.

For at least the foregoing reasons, Applicant submits that the section 112 rejection of the claims is improper and should be withdrawn. “

PETITION FOR EXTENSION OF TIME

Applicant requests that the response period be extended for three months under Rule 1.136. Authorization for payment of the extension fee is included below.

CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing

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in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The Petition for Extension of Time fee in the amount of \$555 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 50-4189, referencing Attorney Docket No. 30064-015001.

Respectfully submitted,

Date: October 2, 2005


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